

### **REMARKS**

Applicant requests reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 1-24 are pending in the present application. Claims 1, 9, and 17 are the independent claims.

Claims 6, 14, and 22 have been amended to improve their form. No new matter has been added.

Claims 1, 2, 5-10, 13-18, and 21-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 8-262751 (Keiichi et al.). Claims 1-24 stand provisionally rejected under the judicially-created doctrine of double patenting over various claims of co-pending Application Nos. 10/459,720, 10/606,147, and 10/453,517 and U.S. Patent No. 6,884,559. All rejections are respectfully traversed.

Independent claims 1, 9, and 17 recite, inter alia, an organic photosensitive layer formed on an electrically conductive substrate, a surface layer of the organic photosensitive layer including at least a binder resin ... [and] having an oxygen gas permeation coefficient of  $5 \times 10^{-13} \text{cm}^3 \text{ (STP) } \cdot \text{cm/s} \cdot \text{cm}^2 \cdot \text{cmHg}$  or less.

However, Applicants respectfully submit that Keiichi et al. does not teach at least the aforementioned feature of independent claims 1, 9, and 17.

Keiichi et al. is understood to relate to a composition for electric charge carrying layers, and an electrophotographic photoreceptor using the composition and to discuss a photoreceptor including an electroconductive base and an undercoating layer under charge generating and electric charge carrying layers. (Keiichi et al., paragraphs [0023] and [0024]). The undercoating layer may include a resin. (Keiichi et al., paragraph [0024]). The Office Action appears to contend that because the resin is allegedly the same as the claimed resin, it would have the same oxygen permeation coefficient. (Office Action, page 2, "As the resin is the same it would have the recited physical properties i.e. oxygen gas permeation coefficient."). This contention is respectfully traversed.

Applicants have reviewed Keiichi et al. and submit that absent from this citation is any express teaching of any layer having an oxygen gas permeation coefficient of  $5 \times 10^{-13} \text{cm}^3 \text{ (STP) } \cdot \text{cm/s} \cdot \text{cm}^2 \cdot \text{cmHg}$  or less. Applicants further note that the Office Action does not provide specific support for the subject contention. And, for a teaching to be inherent, the Office must provide a

basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Manual of Patent Examining Procedure, § 2112, citing Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). For this reason, it has been held that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. Manual of Patent Examining Procedure, § 2112, citing In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversing rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). Applicants respectfully submit that the Office has failed to provide the requisite basis in fact and/or technical reasoning as to why the aforementioned feature is necessarily met by Keiichi et al.

Accordingly, favorable reconsideration and withdrawal of the rejection of independent claims 1, 9, and 17 under 35 U.S.C. § 102 are respectfully requested.

Regarding the provisional obviousness-type double patenting rejection, by separate paper filed concurrently herewith, Applicants have filed a terminal disclaimer disclaiming any patent term in excess of co-pending Application Nos. 10/459,720, 10/606,147, and 10/453,517 and U.S. Patent No. 6,884,559.

In view of the foregoing, Applicant respectfully submits that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.

Applicant believes that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.


There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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